

## REMARKS

### **1. Summary of Office Action**

In the Office Action mailed June 9, 2006, the Examiner rejected claims 22, 25, 28-30, 35, 39, 42, 45-47, 50-52, and 57 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,604,140 (Beck). Further, the Examiner rejected claims 22, 25, 27, 31, 35, 37, 46, 47, 49, 53, 57, and 59 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,038,595 (Ortony) in view of U.S. Patent No. 5,889,942 (Orenshteyn), in further view of U.S. Patent No. 5,909,545 (Frese). Still further, the Examiner rejected claims 26, 28-30, 32-34, 38, 48, 50-52, 54-56, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Ortony, Orenshteyn, Frese and Official Notice. In addition, the Examiner rejected claims 35 and 58 under 35 U.S.C. § 103(a) as being unpatentable over Ortony, Orenshteyn, Frese, further in view of U.S. Patent No. 6,085,030 (Whitehead). Further, the Examiner rejected claims 39, 42, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Frese, in view of Ortony, in further view of Orenshteyn. Still further, the Examiner rejected claims 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Frese and Ortony, in further view of Myers et al. In addition, the Examiner rejected claim 43 under 35 U.S.C. § 103(a) as being unpatentable over Frese and Ortony, in further view of Whitehead.

### **2. Status of the Claims**

Presently pending in this application are claims 22 and 25-60 of which claims 22, 39, and 46 are independent.

### **3. Summary of the Claimed Invention**

Applicants' independent claims 22, 39, and 46 are directed to an apparatus and method for controlling network services using palm sized computers. *See* Applicants' specification at

page 2, lines 1-3. Applicants' specification explains that the "services may never reside on the device and are more suitable for execution by a conventional computer. However, they are *accessible* and can be *controlled* via a lightweight computing device, such as a palm sized computer." See Applicants' specification, page 4, lines 16-19.

As an example, Applicants' specification provides a scenario in which a control application on a palm sized computer is used to control a PowerPoint slide presentation. Applicants' specification explains that an "important element of the control application 210 is a GUI front-end which accepts user input for controlling the PowerPoint presentation (or other application) and a control protocol manager backend which takes user input and translates it into commands to the CPU service." *Id.* at page 11, lines 11-13. As shown in Figure 1 the GUI "allows the user to click on 'forward', 'backward', 'go-to-first-page' or 'go-to-last-page' buttons to control the slide show." *Id.* at page 11, lines 14-15.

Further, on page 27, lines 20-24, Applicants' specification explains that the "console application connects to the Cpu service and informs it about the various other choices. Even though, the Console lists locations for all available Storage/Display/Print services, it does not directly communicate with any of them. Instead, it lets the Cpu service establish links to the selected services and communicate with them as needed based on the task to be performed." Applicants' specification states that that "Cpu service acts as a gateway between the Console and all other connected services." *Id.* at page 27, lines 31-32.

Each of Applicants' independent claims, 22, 39, and 46, is directed to a client notifying a service that the service will act as application host for a set of services and the client downloading code to generate commands for controlling the set of services. In particular, each of Applicants' independent claims 22 and 46, as amended, recites a "console application notifies

a particular service in the group of services that will act as an application host for a set of services to be invoked” and “an input/output device supporting the user interface program, wherein the device includes code that, in accordance with the notification of the set of services, downloads code to generate commands for controlling the set of services.” Similarly, Applicants’ independent claim 39, as amended, recites a method of “establishing a communication link via the network between the portable computing platform and the particular processor, wherein establishing the communication link includes notifying that the processor will act as an application host for a group of services” and “transferring a control program to the portable computing platform via the network, the control program including user interface constructs for generating commands for control of the application and the group of services”.

#### 4. Cited Art

##### a. Beck

Beck’s invention is directed to a method and apparatus that “enables one or more computing devices to discover and use services over a network”. *See* Beck, at abstract. To use a particular service over the network, the device checks its service registry to determine whether that particular service is already loaded. *Id.* at column 6, lines 10-15. According to Beck, if the service is not loaded on the device, then, as shown at steps 503, 504, and 505 in Figure 5, the service registry downloads the service interface, adapter, and implementation. Further, according to Beck, the service interface, adapter, and implementation are entities of a service. *Id.* at column 5, lines 39-41.

Once the three entities (i.e., the service interface, the service adapter, and the service implementation) of the service have been downloaded and once the device has bound a service that it can use, the device can then call on methods that the service provides. *Id.* at column 6,

lines 30-31. For example, in column 6, lines 39-41, Beck teaches that “[i]n step 601, the software client calls a method provided by the services’ interface.” *Id.* at column 6, lines 33-35.

**b. Ortony**

Ortony’s invention is directed to a “network device and a system or computer system for providing network based services in an area defined by a wireless local area network.” *See* Ortony, at abstract. Further, Ortony’s invention is directed to a “system and devices for providing network information access and communication services, and, more particularly, for providing internet related services such as web access and electronic mail services and integration of services and functions through the internet.” *Id.* at column 1, lines 7-12.

**c. Orenshteyn**

Orenshteyn’s invention is directed to a “reciprocal client server network system and, more particularly, to a secured system and method for obtaining application services (i.e., embedded services/applications) from a server and for delivering such services to the requesting client/desktop device, where the service’s application logic (high-level presentation, business, and database logic) is independent from the client’s low-level operating system and I/O peripheral devices.” *See* Orenshteyn, at column 1, lines 6-14.

**d. Frese**

Frese’s invention is directed to providing “a network user with access and control over an application program so that the user may experience the look and feel of the program as well as try the features of the program.” *See* Frese, at column 5, lines 65-67. Frese teaches that a “remote control service published (RCSP) server, preferably a HTTP server displaying HTML documents, provides information about the application programs available for use and demonstration.” *Id.* at column 4, lines 17-20.

Further, Frese teaches that “[i]n response to an activation request by a user, the RCSP server sends a file containing the executable code for a remote display module (RDM) to the browser. Preferably, the browser includes an interpreter which executes the RDM. This execution opens an application window for the remote display module and remote display module communicates with the local resource interface in the user’s computer.” *Id.* at column 4, lines 25-32.

#### **5. Response to Examiner’s Rejections under 35 U.S.C. § 102(e)**

As noted above, in the Office Action mailed June 9, 2006, the Examiner rejected claims 22, 25, 28-30, 35, 39, 42, 45-47, 50-52, and 57 under 35 U.S.C. § 102(e) as being anticipated by Beck. Applicants respectfully traverse the anticipation rejection, because the Examiner has not established that Beck teaches each and every element of independent claims 22, 39, and 46 as would be required to support an anticipation rejection under M.P.E.P. § 2131. In particular, the Examiner has not established that Beck teaches a client downloading code to generate commands for controlling a set of services.

Rather, as noted above, Beck teaches a method of downloading three entities of a service (i.e., the service interface, adapter, and implementation) and then using the downloaded entities to call on methods to carry out the service on behalf of a client. For example, Beck states that “[i]n step 601, the software client calls a method provided by the services’ interface.” *See* Beck, at column 6, lines 33-35. As another example, Beck states that “[i]n step 604 the service implementation method is executed, wherein the service performs the requested function on behalf of the client.” *Id.* at column 6, lines 39-41.

Calling methods and performing a service on behalf of a client, however, does not amount to a device downloading code to generate commands for controlling a set of services.

Further, according to Beck, the execution of a service may take place locally on the client and/or at a remote location. *Id.* at column 7, lines 12-26. As an example, Beck teaches that a PDA can be used “to discover a remote service at an airport kiosk that communicates with an airlines on-line database to provide the user with updated flight information.” *Id.* at column 7, lines 21-25. In this example, Beck, however, does not teach that client downloads code and then uses the downloaded code to generate commands to control the airport kiosk. Rather, according to Beck the PDA merely looks up information via an airport kiosk and presents it to the user.

As another example, Beck teaches that a printer service “can be a remote service, since execution may occur on the remote computer that manages the print spool, as well as on the device using the printer service.” *Id.* at column 7, lines 18-21. Executing services, either locally or at a remote location, however, does not amount to a device downloading code to generate commands for controlling a set of services.

Thus, the Examiner has failed to establish that Beck teaches a downloading code to generate commands to control the set of services, as required by Applicants’ independent claims 22, 39, 46. Consequently, Beck does not anticipate any of these claims. Each of claims 25-38, 40-45, and 47-60 depends from, and thus incorporates all of the limitations of, one of these independent claims. Thus, for at least the same reason, Beck also does not anticipate any of these dependent claims.

**6. Response to Examiner’s Rejections under 35 U.S.C. § 103(a)**

***a. No Motivation to Combine References***

As noted above, in the final Office Action mailed June 9, 2006, the Examiner rejected independent claims 22 and 46 under 35 U.S.C. § 103(a) as being unpatentable over Ortony in view of Orenshteyn, in further view of Frese. Further, the Examiner rejected independent claim

39, under 35 U.S.C. § 103(a) as being unpatentable over Frese, in view of Ortony, in further view of Orenshteyn.

On page 6 of the final Office Action mailed June 9, 2006, the Examiner stated that the “rejections set forth in the previous action, filed 12.22.2005, are maintained.” On pages 7-10 of the final Office Action, while rejecting Applicants’ claims, the Examiner did not provide a new ground for rejection for any of the claims. Thus, when addressing the rejections made in the final Office Action, Applicants will also refer to the non-final Office Action mailed December 22, 2005.

According to M.P.E.P. § 2143, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* M.P.E.P. § 2143.

In addition, “a statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art **is not sufficient** to establish a *prima facie* case of obviousness without some **objective reason** to combine the teachings of the references.” *See* M.P.E.P. § 2143.01 (bold emphasis added).

Further, it is impermissible to use Applicants’ claims as a blueprint for hindsight reconstruction. *In re Fritsch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (explaining that the “mere

fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification," and noting that it is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art).

On page 8, paragraph 19 of the non final Office Action mailed December 22, 2005, the Examiner cited column 7, lines 43-51 in Ortony and as motivation for combining Ortony with Frese, and stated that "it would have been obvious to one of ordinary skill in the art to modify Ortony's 'device programs' functionality with the downloading and 'executable code' functionality disclosed by Frese." The Examiner continued by stating that "[o]ne would have been particularly motivated to provide such functionality in Ortony to allow programs to be dynamically loaded into the network device, enabling Ortony's portable device to communicate with a wide variety of applications."

The Examiner's citation of column 7, lines 43-51 in Ortony does not suggest the desirability of modifying Ortony to control a set of services by downloading code to generate commands for controlling the set of services. Rather, column 7, lines 43-51 in Ortony teaches a method of adding programs such as "a basic word or text processing program or a notes type program together with a alphanumeric keyboard" so that a network service device can be used as a message board by a number of users, such as members of a family.

This portion in Ortony merely suggests that the network service device may have several users, and have additional software on it, but does not provide any objective reason to combine Ortony with Frese. Regardless of whether Ortony modified as suggested by the Examiner (by adding downloadable programs able to control other software) would improve Ortony by "enabling Ortony's portable device to communicate with a wide variety of applications," such an



assertion is not a motivation to make such a modification to Ortony. Indeed, if making an improvement to the prior art were all that were necessary to justify combining disparate elements of the prior art, then no combination of elements resulting in an improved system would be patentable. Thus, Applicants respectfully submit that the Examiner has not provided a well-reasoned statement showing some suggestion of the desirability of downloading code to generate commands for controlling a set of services.

Further, on page 9 of the non final Office Action, the Examiner further combined Orenshteyn with Ortony by citing column 5, line 65 to column 5, line 51 and column 9, lines 59-67 and stated that "Orenshteyn discloses an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked". The Examiner's reasoning as to why a person of ordinary skill would be motivated to combine Ortony and Orenshteyn is "to provide a service in the group of services that enhances a client's ability to access the other services." Applicants respectfully submit that the Examiner has impermissibly used Applicants' claims as a template to select elements from the prior art and piece them together, and has not provided any objective reasoning to combine the references. Applicants therefore submit that the pending claims are in condition for allowance, and such action is respectfully requested.

***b. The References do not Include All the Claim Elements***

Even if the combination of references as set forth by the Examiner is appropriate (which Applicants do not concede), none of the references teach the limitations of (i) "notifying a particular service in the group of services that will act as an application host of a set of services to be invoked," or (ii) "downloads code to generate commands for controlling the set of services." The Examiner concedes that Ortony does not disclose either of these elements (page 8,

Office Action mailed December 22, 2005), so Applicants will discuss Frese and Orenshteyn below.

**1. "notifying a particular service of a set of services to be invoked"**

Neither Frese nor Orenshteyn disclose a device notifying a service to act as an application host of a set of services. Frese does not disclose notifying a host of services to be invoked, and indeed, the Examiner has not relied upon Frese for this element.

With respect to Orenshteyn, the portions cited by the Examiner do not disclose or suggest notifying a particular service acting as an application host of a set of services to be invoked. Applicants submit the following for each the portions in Orenshteyn as cited by the Examiner:

- Column 5, line 65 to column 5, line 51: This portion in Orenshteyn teaches a method of launching an application via a directory service. According to Orenshteyn, "services may be chained together so that the client user can reference multiple applications by different vendors, residing on different servers." Further, Orenshteyn teaches that a "user can 'roam' the network of 'directory' services until he/she finds the appropriate application for his task." This portion in Orenshteyn, however, fails to teach notifying a host service of a set of services to be invoked. Rather, this portion merely teaches that services can be cross-referenced or chained to other services via a directory service.
- Column 9, lines 59-67: This portion in Orenshteyn teaches that application programs may be utilized via the use of a directory service. This portion too fails to teach notifying a host service of a set of services to be invoked.

**2. "downloads code to generate commands for controlling the set of services"**

Neither Frese nor Orenshteyn disclose a device downloading code to generate commands for controlling a set of services. With respect to Frese, Frese teaches a method of merely providing "a network user with access and control over an application program so that the user may experience the look and feel of the program as well as try the features of the program." *See* Frese, at column 5, lines 65-67. According to Frese, a server sends a "file containing executable code for remote display module (RDM)". *Id.* at column 4, lines 28-29.

Frese's method of sending a file containing executable code and allowing a user to remotely control an application does not amount to, however, to a device downloading code to generate commands for controlling a set of services.

Further, Orenshteyn also fails to disclose a device downloading code to generate commands for controlling a set of services. Rather, Orenshteyn teaches a server encoding a "command packet according to OSSI protocol" which is then "dispatched to the client's quasi-OS via the common transport protocol (such as tcp/ip)." According to Orenshteyn, the client's quasi-OS can "recognize the received, OSSI encoded, packets for performing the desired I/O or control operation." *See* Orenshteyn at column 5, lines 25-31.

Orenshteyn's method of a server sending command packets from a server to a client for merely executing I/O operations or controlling operations on the client device, however, does not amount to a client device downloading code to generate commands (which are sent back to the host) for controlling a set of services as described in and claimed in Applicants' invention.

On page 6 of the final Office Action, the Examiner cited the above mentioned portion in Orenshteyn (column 5, lines 25-31) and stated that "Orenshteyn discloses that the quasi-OS is explicitly controlled using interface constructs submitted by the server." The Examiner further

stated that the “quasi-OS, generates, the interface constructs which are then incorporated into the user interface by the quasi-OS.”

As noted above, this portion in Orenshteyn does not teach that the command packets sent from the server to the client are used to generate commands for controlling a set of services. Rather, this portion in Orenshteyn teaches that the server sends command packets to the client’s quasi-OS which are then merely executed on the client device.

Thus, in the Examiner's hypothetical combination of Ortony, Orenshteyn and Frese, there is no teaching of (i) notifying a particular service that will act as an application host, of services to be invoked *and* (ii) downloading code to generate commands for controlling a set of services. Applicants have found nothing to suggest that such a hypothetical combination would notify a particular service to act as an application host and download code to generate commands for controlling a set of services.

Thus, the combination of Ortony, Frese, and Orenshteyn fails to teach all of the limitations of any of claims 22, 39, and 46. Because the combination of Ortony, Frese, and Orenshteyn fails to teach all of the limitations of claims 22, 39, and 46, a *prima facie* case of obviousness of claims 22, 39, and 46 has not been made. Therefore, Applicants submit that claims 22, 39, and 46 are allowable. Further, Applicants submit that claims 25-38, 40-45, and 47-60 are also allowable for at least the same reason that they each depend from allowable claims 22, 39, and 46.

***c. Response to Examiner’s Assertions of Official Notice***

In the Office Action of June 9, 2006, the Examiner stated that due to Applicants' failure to rebut the Official Notice set forth in the earlier Office Action mailed December 22, 2005, that the Official Notice is deemed to be admitted prior art. However, Applicants dispute the

Examiner's contention, and respectfully submit that the Examiner has inappropriately extended the use of Office Notice, and that Applicants did in fact rebut the essence of the Examiner's conclusions set forth as Official Notice.

Under M.P.E.P. 2144.03(A) "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known."

On page 11 of the non-final Office Action of December 22, the Examiner stated "that services such as a slide presentation, calendar program, control of appliance, print and fax services, speech translation and room reservation function are well known in the art are not patentably distinct as they are merely fields of use." The Examiner then asserted that "[t]herefore, *Official Notice* is taken that *one of ordinary skill in the art would have reasonably implemented the aforementioned services in Ortony* to provide a greater range of functionality of services available to the user." (emphasis added). Applicants submit that the Examiner's statement that the proposed modifications to the Ortony reference were reasonable to one skilled in the art are legal conclusion of obviousness, *not* assertions of well-known facts, which is the intent of Official Notice.

Thus, while Applicants concede with the Examiner's assertion that slide presentations, calendar programs, control of appliances, print and fax services, speech translation, and room reservation functions are well known in the art, Applicants submit that the Examiner's use of Official Notice as to the combination and modification of the Ortony reference is improper. Furthermore, Applicants arguments made in rebuttal to those obviousness-based rejections

serves as sufficient rebuttal to the purported Official Notice, and should not be deemed to have admitted any of the Examiner's conclusions.

**7. Conclusion**

In view of the foregoing, Applicants submit that claims 22 and 25-60 are allowable, and thus Applicants respectfully request favorable reconsideration and allowance of these claims. Should the Examiner wish to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913- 3305.

Respectfully submitted,

**McDONNELL BOEHNEN  
HULBERT & BERGHOFF LLP**

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By:



Robert J. Irvine III  
Registration No. 41,865